

Hearing:
May 20, 1997

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RLS/TLW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JAN 8,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Deutsche Star GmbH

Serial No. 74/508,101

Joe Jest of Anderson Kill Olick, P.C. for Deutsche Star GmbH.

Thomas W. Wellington, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Hanak and Quinn, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Deutsche Star GmbH (applicant), a limited liability company of the Federal Republic of Germany, has appealed from the final refusal of the Trademark Examining Attorney to register the mark RAIL SEAL for cover strips for linear bearing rails.¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), arguing that applicant's mark is merely

¹ Application Serial No. 74/508,101, filed April 1, 1994, based upon applicant's bona fide intention to use the mark in commerce under Section 1(b) of the Act, 15 USC 1051(b).

descriptive of its goods. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

The Examining Attorney argues that the term RAIL SEAL is merely descriptive of a feature of applicant's goods. According to the Examining Attorney, the word "rail" is descriptive as the goods are cover strips for linear bearing rails. Because a "seal" is "anything that tightly or completely closes or secures a thing, as closures or fasteners for doors and railroad cars ...," and because the cover strip provides such a closure or seal for the linear bearing rails, the mark as a whole is merely descriptive, according to the Examining Attorney.

The Examining Attorney points to excerpts from patents made of record during the prosecution of this case in which the terms "rail" and "seal" are used in close proximity in the linear motion rolling guide unit industry to describe components. For example, the Examining Attorney refers to the excerpt from Patent No. 5,109,720:

...seal plate covers the opening at the upper portion of the guide rail. The seal plate may be made of magnetic material, and magnets may be provided on the upper ends of both the side walls of the guide rail so as to insure close contact between the seal plate and the guide rail.

The Examining Attorney refers to other statements made in two other patents.

In a conventional linear motion rolling guide unit, when a slider slides on a track rail, the seal between the slider and the track rail is provided by end seals mounted at both ends of the slider and an under seal mounted to the underside of the slider. (Patent 5,306,089)

... when the slider is assembled on the guide rail, the side seal is naturally adapted to the surfaces of the guide rail and the seal lips of the side seal satisfactorily contact the surfaces of the guide rail to be sealed... (Patent 5,149,204)

The Examining Attorney argues that applicant's goods are a metal seal plate being attached or enclosing the guide rail. Therefore, according to the Examining Attorney, the cover strips attached to guide rails act as "seal plates" which enclose the top portion of the guide rail. Applicant's goods, in effect, "seal the rail" and are seals for linear rail guides.

Applicant, on the other hand, argues that its cover strips do not function as seals. Further, applicant argues that the evidence of record shows that any seals are mounted on the sliders for conventional linear motion rolling guide units and not on the track rails. Applicant maintains that the seals mounted on the sliders do not perform the same function as applicant's cover strips mounted on bearing rails. Its cover strips do not, according to applicant, substitute for the seal of a slider in the rolling guide unit. Therefore, it requires some imagination to conclude

that RAIL SEAL describes cover strips or a feature thereof. At most, the term is suggestive of goods which may be mounted on a track rail, applicant argues.

Upon careful review of this record and the arguments of the attorneys, we believe that the record is insufficient to demonstrate that the asserted mark is merely descriptive of applicant's cover strips for linear bearing rails. While it is true that the excerpts noted by the Examining Attorney use the words "seal" and "rail" in close proximity, show that "seal plates" may be attached to guide rails in the linear motion rolling guide unit industry and that bearing rails may be sealed by the use of end seals incorporated into sliders for rolling guide units, we believe that this application presents a case where applicant has combined two terms which have some descriptive significance in the field but that the composite is registrable because the unitary term created has a non-descriptive, albeit suggestive, meaning with respect to applicant's particular goods. The only instance we could find in which the term "rail seal" appears (excerpt from Patent 5,203,502) deals with improvements in rail insulating pads used to insulate rails from rail ties. Although applicant's cover strips may, in a manner of speaking, act very generally as a type of "seal" for bearing rails, the evidence is simply insufficient to persuade us that the combination RAIL SEAL is merely

descriptive of applicant's cover strips. While the term may have more immediate descriptive significance with respect to such goods as sliders, which may have seals mounted thereon, a cover strip mounted on a bearing rail is simply a different product. If we had any doubt on the question of mere descriptiveness, that doubt, in accordance with precedent, should be resolved in favor of publication. See *In re Merrill Lynch, Pierce Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

Decision: The refusal of registration is reversed.

R. L. Simms

E. W. Hanak

T. J. Quinn
Administrative Trademark
Judges, Trademark
Trial and Appeal Board